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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,518	07/11/2003	Edward J. Mueller	31660-1001	6589
5179	7590	06/02/2006		
PEACOCK MYERS, P.C. 201 THIRD STREET, N.W. SUITE 1340 ALBUQUERQUE, NM 87102				EXAMINER SILBERMANN, JOANNE
				ART UNIT 3611 PAPER NUMBER

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/618,518	MUELLER, EDWARD J.
	Examiner Joanne Silbermann	Art Unit 3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 March 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 26-32,34-63 and 65-89 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 26-32,34-63,65-89 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the banner attached directly to said lateral surface (claims 26 and 63) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

2. Claim 65 is objected to because of the following informalities: Claim 65 depends from claim 64 which has been canceled. For purposes of examination, it is assumed that claim 65 depends from claim 63. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 26-30,32,34-58,60,63,65-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang, US #6,192,824 or, alternatively, Chang in view of Howard, US #1,256,232.

5. Chang discloses a lighted pole and banner assembly comprising a support comprising hollow transparent cylinder 2 having no openings in its lateral surface, banner 11 attached to the lateral surface of the cylinder, light source (bulb) 31 disposed within the support between the two ends and illuminating an entire circumference of substantially the entire length of the support so that illumination is visible from any sufficiently close exterior position around the support and the light source illuminates the banner.

6. The banner of Chang is considered to be attached directly to the lateral surface of the cylinder, as best as can be understood from Applicant's drawings, particularly

Figure 1.

7. Each banner of Chang is considered to be a single banner, but Chang does not particularly teach using only a single banner. However, the number of banners supported on the pole is considered to be entirely a matter of design choice. It would have been obvious to a person having ordinary skill in the art to utilize as many or as few banners as necessary to provide the desired display. Also, since Applicant has not stated that only one banner solves any stated problem or is for any particular purpose it appears that more than one banner would perform equally well.

8. Alternatively, Howard teaches using a single banner mounted to a lighted pole. It would have been obvious to one of ordinary skill in the art to utilize a single banner, as taught by Howard, on a lighted pole as shown in Chang so that only a single display need be removed to be replaced.

9. The light source extends uninterrupted along the length of the support (Figure 1).

10. The display is mounted to a surface (column 2 lines 53-55).

11. The following rejections may also be considered applicable to Chang as modified by Howard.

12. Chang does not teach the support as being a plurality of sections. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the support from several pieces, since it has been held that constructing

a formerly integral structure in various elements involves only routine skill in the art.

*Nerwin v. Erlichman*, 168 USPQ 177, 179.

13. Chang does not teach using LEDs, rope lights, neon, fluorescent lights, or fiber optics. These light sources are all old and well known in the art. It would have been obvious to one of ordinary skill to utilize a different light source as an alternative equivalent. It also would have been obvious to utilize a different light source so as to use less electricity and require less frequent changing of lights.

14. Chang does not teach different colors, however the particular color of the lights is considered to be entirely a matter of design choice. Matters relating to ornamentation only, and having no mechanical function, cannot be relied on where claims are not directed to design but are structural claims. *In re SEID*, 73 USPQ 431 (CCPA 1947). It would have been obvious to a person having ordinary skill in the art to utilize any known color for the lights so as to provide the desired type of display.

15. Chang does not teach varying brightness, blinking lights, or sequential lighting, however these are common. Dimmer switches are well known in the art of illumination and blinking and sequential lighting are commonly used. It would have been obvious to utilize a dimmer function for the light sources so that the appropriate amount of illumination may be employed. It also would have been obvious to utilize blinking or sequential lighting to attract attention to the display.

16. Chang does not specifically teach using polymeric material or acrylic, however these materials are well known in the art. It would have been obvious to one of ordinary skill in the art to utilize these materials since it has been held to be within the general

skill or a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

17. Chang does not teach specifically mounting the assembly on a vehicle, however this is old and well known in the art. Illuminated displays mounted to the tops of vehicles are common, especially among delivery services. It would have been obvious to mount the assembly of Chang atop a vehicle so that the display may be more easily seen.

18. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (or Chang and Howard) as applied to claim 26 above, and further in view of Taylor, US #2,509,707.

19. Chang (or Chang and Howard) does not teach using a luminescent support, however this is well known in the art. Taylor teaches a hollow, luminescent support having illumination disposed within the support (Figures 1 and 2). It would have been obvious to one of ordinary skill in the art to utilize a luminescent support so as to provide a different looking display, and to provide a support that glows after the light is turned off.

20. Claims 59, 61 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (or Chang in view of Howard) as applied to claim 26 above, and further in view of Siew, US #4,833,443.

21. Chang (or Chang and Howard) does not teach a holder having arms, however such a holder/bracket is well known in the art. Siew teaches a bracket for mounting an illuminated display including electrical cord 15 accommodated by bracket 7 having

space 11 between tow arms (Figure 1). It would have been obvious to one of ordinary skill to utilize such a bracket so that the display may be mounted over a window or other thin object (as shown by Siew).

### ***Response to Arguments***

22. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.
23. A new ground of rejection has been made in response to Applicant's amendments to the claims stating that the banner is a single banner and the entire length of the support is illuminated.
24. Applicant argues that Chang does not teach the entire length of the support as being illuminated, however, this is clearly shown by Chang. Support 2 is described as a "transparent hollow tube" (column 2 lines 7) having light bulbs 31 therein. Therefore, the tube is illuminated along its entire length, around its entire circumference.
25. Applicant also argues that the banner is directly attached to the cylinder. As best as this can be understood from the drawings (specifically Figure 1) it appears that Chang teaches this. Applicant's banner is attached "directly" to the cylinder by means of some attachment device, as shown in Figure 1. Accordingly, Chang teaches a banner attached directly to the cylinder by attachment device 12.

***Conclusion***

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Silbermann whose telephone number is 571-272-6653. The examiner can normally be reached on M-F 5:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Joanne Silbermann  
Primary Examiner  
Art Unit 3611

js  
26 May 2006